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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,272	07/03/2003	Mark J. Mamula	102321-201	4375

27267 7590 09/11/2007

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EXAMINER	
CANELLA, KAREN A	
ART UNIT	**PAPER NUMBER**
1643	

MAIL DATE	DELIVERY MODE
09/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/613,272	MAMULA, MARK J.	
	Examiner	Art Unit	
	Karen A. Canella	1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1,2,4,5,10-14,17-22 and 25-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1, 2, 4, 5, 10-14, 17-22, 25-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 10, 17 and 25-28 have been amended. Claims 3, 6-9, 15, 16, 23, 24 and 29 have been canceled. Claims 1, 2, 4, 5, 10-14, 17-22, 25-28 are pending and under consideration. The species of "bacterial proteins" and "viral proteins" are hereby rejoined to the previous examined species of "tumor antigens".

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4, 5, 10-14, 17-22, 25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of inducing an immune response which is a humoral immune response, does not reasonably provide enablement for a method of inducing an immune response which is a cellular immune response. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.
The factors considered when determining if the disclosure satisfies the enablement requirement and whether any necessary experimentation is undue include, but are not limited to: 1) nature of the invention, 2) state of the prior art, 3) relative skill of those in the art, 4) level of predictability in the art, 5) existence of working examples, 6) breadth of claims, 7) amount of direction or guidance by the inventor, and 8) quantity of experimentation needed to make or use the invention. In re wands, 858 F.2d 731, 737.8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The instant claims require the "enhancement" of the immune response of a patient after administering to said patient tumor antigens, bacterial proteins or viral proteins wherein said proteins have been modified to isoaspartic containing proteins by exposure to adenosine dialdehyde. When given the broadest reasonable interpretation, the enhancement of the immune response includes both an enhancement of a humoral immune response and an enhancement of a cellular immune response. The prior art teaches that self, non-immunogenic proteins can be modified to contain isoaspartic acid residues and that the result of said modification is an

induction of an antibody response against both the isoaspartyl modified proteins and the corresponding non-modified protein (Mamula, Immunological Rev, 1998, Vol. 164, pp. 231-239 and Mamula et al, J Biol Chem, 1999, Vol. 274, pp.22321-22327). However the art teaches that T-cells are elicited which recognize the isoaspartyl proteins but do not recognize the non-modified, non-isoaspartic acid containing proteins (Mamula, ibid, page 233, second column, last sentence and Mamula et al, page 22325, second column, first paragraph under "Discussion"). In the instant specification, T c ells are isolated from a mouse which was immunized with an isoaspartyl containing protein and said T cells were incubated in vitro for 7 days with the non-modified target cell and Il-2. This fails to support a claim which includes eliciting a cellular immune response in a patient by the administration of the isoaspartyl modified proteins or peptides. One of skill in the art would be subject t undue experimentation with reasonable expectation of success in order to carry out the broadly claimed methods.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke et al (U.S. 5,169,862).

Burke et al disclose an analogue of viscosin which includes a D-beta-Asp residue (column 3, line15). Burke et al disclose that viscosin is a cyclic peptide isolated from Pseudomonas, thus fulfilling the requirement of a bacterial protein comprising an isoaspartic acid residue. Burke et al disclose intravenous injections (column 4, lines 53-55), compositions comprising sterile aqueous or non-aqueous solutions including water, which fulfills the limitation of claim 28 and lactated Ringer's which fulfils the specific embodiments f claim 27 requiring electrolyte solutions.

All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571)272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karen A. Canella/
Ph.D., Primary Examiner
Art Unit 1643